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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,880	08/04/2003	Philip G. Wessells	20003-7012	5236

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MICHAEL E. WOODS
PATENT LAW OFFICES OF MICHEAL E. WOODS
112 BARN ROAD
TIBURON, CA 94920-2602

EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/633,880	Applicant(s) WESSELLS ET AL.	
	Examiner Donald Heckenberg	Art Unit 1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on June 9, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 19-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 17, 18, 23 and 24 is/are rejected.
- 7) ☒ Claim(s) 13-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

1. The numbering of claims is not in accordance with 37 CFR 1.126. The claims start with numbers 1-6, then repeat 5 and 6, and then conclude with 7-22. The second referenced claims 5 and 6 have been renumbered as 7 and 8, and the rest of the claims have been correspondingly renumbered to result in claims 1-24 being pending.

It is noted that renumbered claims 8 and 9 (formerly labeled 6 and 7) originally recite as though depending on claim 5. Yet, as noted above, there are two different claim 5 according to the original numbering. Given the disclosure of the instant application as well as the claim structure, renumbered claims 8 and 9 have been interpreted as though depending from renumbered claim 7 (which was originally numbered as the second claim 5). Appropriate clarification is required on this issue.

2. Applicants' election of Group I (claims 1-18, 23, and 24, noting the claim renumbering discussed above) in the reply filed on June 9, 2004 is acknowledged. Because Applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse. MPEP § 818.03(a).

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3. Claim 10 is objected to because of the following informalities: the claim starts out by reciting "7The apparatus of claim 7..." The "7" at the beginning appears to be a typographical error. Appropriate correction is required.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6, 12, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by anticipated Blevins et al. (U.S. Pat. No. 3,059,273).

Blevins discloses a snowball forming and ejecting device. The device comprises a shaft (34), with a scoop (42) coupled to the distal end of the shaft for collecting a bolus of a snow. A former (12) is coupled and mating with the scoop for molding and compressing the snow into a spherical ball retained within the scoop (cl. 2, ll. 34-50). The device is as such to have a closed position relative to the scoop when the snow is molded in the ball when the scoop and former juxtapose to form a spherical

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shell (shown in fig. 2), as well as have an open position for releasing the snowball (shown in fig. 3).

6. Claims 1-6, 11, 12, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Pickering (U.S. Pat. No. 436,818).

Pickering discloses a device comprising an arched shaft (B) with a scoop (F) coupled to a distal end of the shaft (see fig. 1). A former (E) is coupled to, and mating with, the scoop, with the scoop and former creating a generally spherical shell when the two sections are juxtaposed (see fig. 8).

Pickering further discloses the scoop and shaft coupled together using a mating system. Specifically, the mating system comprises a threaded member (G') coupled to the scoop and a complementary member (H) coupled to the shaft (see fig. 2).

The claims of the instant application recite an intended use for the device. Specifically, the device is recited as to be used for collecting and compressing a compressible medium, with the compressible medium more specifically being recited as snow. It is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus claims. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370

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F.2d 576, 580 152 USPQ 235, 238 (Cust. & Pat. App. 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (Cust. & Pat. App. 1963); MPEP § 2115. In the instant case, Pickering discloses all of the structural features of the claimed apparatus, and is therefore clearly capable of being used with a compressible medium such as snow. Pickering therefore anticipates the claimed use limitations of the claims.

7. Claims 1-8, 11, 12 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson (U.S. Pat. No. 2,003,197).

Jackson discloses an apparatus comprising an arched shaft (7) and a scoop (1) coupled to the distal end of the shaft (see fig. 2). A former is coupled to the distal end of the shaft to mate with the scoop and thereby define a spherical shell (see fig. 1). Jackson also discloses the apparatus to be as such to be biased to an open position in which the scoop is separated from the former (p. 1, cl. 1, l. 55 - p. 1, cl. 2, l. 6).

As noted above in the rejection in view of Pickering, the claimed use of the apparatus of the instant invention is not germane to the issue of patentability. As Jackson discloses all of the recited structural features of the claims, Jackson could

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clearly be used in the claimed manner, and therefore anticipates the use limitations.

8. Claims 1-7, 9, 10, 23, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Bodenstein (U.S. Pat. No. 996,449).

Bodenstein discloses an apparatus comprising a shaft (A) with a scoop (B) coupled to the distal end of the shaft (see fig. 1). A former, or trapper, (C) is coupled to the scoop which when juxtaposed to the scoop forms a generally spherical shell (see fig. 2).

Bodenstein further discloses the former operable to be moved from an open to closed position, with a latching mechanism (D) provided for inhibiting the former from returning to the open position. As shown in fig. 2, the latch comprises a release for disengaging the latching mechanism. Note, given the position of the apparatus shown in the figures, the former is inherently biased to an open position as gravity acts to swing the former downward to the open position.

As noted above in the rejection in view of Pickering, the claimed use of the apparatus of the instant invention is not germane to the issue of patentability. As Bodenstein discloses all of the recited structural features of the claims, Bodenstein

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could clearly be used in the claimed manner, and therefore anticipates the use limitations.

9. Claims 13-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest an apparatus as defined in claim 13 of the instant application. The closest prior art disclosed by Blevins, Pickering, Jackson, and Bodenstein is described above, and additional close prior art is cited and described below. None of these references teach or suggest an apparatus with a shaft, scoop, and former, with the shaft including a ski pole as defined in claim 13.

11. The following references cited but not relied upon are deemed pertinent to the instant application:

Smith (U.S. Pat. No. 2,948,275) discloses a snowball maker and launcher.

Erickson (U.S. Pat. No. 3,472,217) discloses a device for forming and throwing snowballs.

Upright (U.S. Pat. No. 3,836,308) discloses a snowball forming device.

Stern et al. (U.S. Pat. No. 4,136,639) discloses a snowball maker.

Maerz et al. (U.S. Pat. No. 4,859,167) discloses a snowball maker.

Zimmerman et al. (U.S. Pat. No. 5,000,153) discloses a device for making and throwing snowballs.

German Pub. No. 20300813U1 discloses a single handed snowball thrower.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The

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examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (571) 272-1151. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

 7/26/04
Donald Heckenberg
A.U. 1722